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| 09/976,642      | 10/11/2001  | Robert E. Haines     | 10007583-1          | 2054             |

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
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EXAMINER

POND, ROBERT M

ART UNIT PAPER NUMBER

3625

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/976,642

Applicant(s)

HAINES ET AL.

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-20 and 28-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-20, and 28-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant amended claims 1-4, 6-15, 18, 28, 29, 31-33, canceled claims 5 and 21-27, and newly added claim 36-40. All pending claims 1-4, 6-20, and 28-40 were examined in this final Office Action necessitated by amendment.

### ***Response to Arguments***

#### **Pertaining to Rejection under 35 USC 103 in previous office action**

Applicant's arguments filed 14 November 2005 have been fully considered but they are not persuasive.

Regarding the use of "more proactive," the Examiner was citing directly from IA, Item: UU, regarding Internet appliances technology making printers proactive. The Examiner injected the word "more" and withdraws this from the office action and believes it has absolutely no bearing on grounds of rejection or motivation to combine.

The Applicant argues the Examiner is employing hindsight in combining IA and Manchala. IA teaches a) internet appliances becoming proactive using embedded web server technology, b) incorporating e-mail into a Xerox color laser to send email to an administrator when the printer requires or will soon require service (please note examiner's interpretation: proactive monitoring

improves printer availability to users), and c) a web-enabled printer sending an email directly to a supplier to deliver a toner cartridge once a toner low condition is detected. IA teaches Xerox's involvement with Internet appliance. One of ordinary skill in the art reviewing IA should be curious about what specifically Xerox has to offer or may have patented. Separate from Xerox, Manchala provides teachings pertinent to Internet appliances that one of ordinary skill in the art would seek to fill gaps in IA pertaining to technology and use of such technology.

IA (Item: UU) specifically states "Having an Internet appliance send e-mail for service notification seems an obvious use of e-mail." Given the teachings of IA as a whole, this statement clearly suggests an obvious use of e-mail.

The Applicant amended language in claim 15 adding a retransmission requirement not previously claimed. Rather than permit direct transmission from the peripheral, the Applicant is adding a step that the email be sent to a personal computer associated with the peripheral device for retransmission from the personal computer to a vendor web site. The prior art cited teaches a printer sending an e-mail directly to supplier to deliver a toner cartridge and further teaches the same printer alerting the office manager whenever there is a paper jam via e-mail. One of ordinary skill in the art would recognize that the e-mail being sent to a supplier can just as easily be routed to an office manager due to business decisions requiring human approval first. IA (Item: UU) supports this by specifically stating that proactive devices e-mail notification directly to the

administrator when the printer requires or will soon require service. Given the teachings of IA as a whole, a depleted toner cartridge that renders the printer inoperative is reason for a printer to require service. The prior art teaches both scenarios of e-mail usage, placing an order from the peripheral directly to a supplier or administrator. Manchala teaches communicating with an authorization service and a purchasing service, and the purchasing service places the order. IA and Manchala teach and suggest direct transmission and retransmission.

Pertaining to Rejection under 35 USC 101

Applicant canceled claims 21-27. Rejection under 35 USC 101 is withdrawn.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-4, 6-20, and 28-40 are rejected under 35 USC 103(a) as being unpatentable over Internet Appliances (a collection of prior art cited in PTO-892, Items: X and UU hereinafter referred to as "IA") in view of Manchala (Paper # 20040726, US 6,405,178).**

IA discloses embedding web servers into peripheral equipment to move from simple one-way file transfer to two-way web technology that manages and

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monitors a printer, sends and receives email regarding printer status (e.g. status of consumables, requires service now or will in the future required service) (X: see at least page 2; UU: see at least page 1). IA further discloses:

- Determining by a process within a peripheral device that an amount of a consumable associated with the peripheral device has decreased below a pre-determined threshold: networked printer notifies an administrator when the printer is running out of paper, needs toners, or has a paper jam (UU: see page 2).
- Transmitting an email from the peripheral device to order additional supplies of the consumable: when toner is low, sending an email to a supplier to deliver the toner cartridge (X: see page 3).
- Requesting periodic maintenance: Internet appliance sends urgent email to request periodic maintenance (UU: see page 2).
- Retransmission:

IA teaches all the above as noted under the 103(a) rejection and teaches a) internet appliances becoming proactive using embedded web server technology, b) incorporating e-mail into a Xerox color laser to send email to an administrator when the printer requires or will soon require service (please note examiner's interpretation: proactive monitoring improves printer availability to users), and c) a web-enabled printer sending an email directly to a supplier to deliver a toner cartridge once a toner low condition is detected, but does not specifically disclose ordering the toner cartridge. Manchala teaches an electronic commerce enabled

purchasing system, whereby when a networked printer determines a toner low threshold condition, it sends an event notification to the network server which will order toner directly from an online supplier via email messaging across a firewall (see at least abstract; col. 3, lines 25-36; col. 4, lines 15-22). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of IA to order consumables from the supplier who delivers the toner using email across a firewall as taught by Manchala, in order to be proactive in printer servicing, and thereby increase printer availability to users.

IA teaches all the above as noted under the 103(a) rejection and teaches a) a printer sending an e-mail directly to supplier to deliver a toner cartridge and the same printer alerting the office manager whenever there is a paper jam via e-mail, and b) sending e-mail notification directly to the administrator from the printer when the printer requires or will soon require service, but does not mention retransmission. Manchala teaches all the above as noted under the 103(a) rejection and further teaches communicating with an authorization service and a purchasing service, and the purchasing service placing the order with the vendor (please note: Manchala is discloses electronic communication with vendors) (see at least col. 4, lines 27-29). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of IA to retransmit an e-mail from the purchasing service to the vendor as taught by Manchala, in order to service the requesting device.

*Pertaining to computer-usable medium claims 8-14*

Rejection of claims 8-14 is based on the same rationale as noted above.

*Pertaining to system claims 15-20, 34, and 35*

Rejection of claims 15-20, 34, and 35 is based on the same rationale as noted above



***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond  
Primary Examiner  
January 23, 2006